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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,767	03/23/2004	Yuko Nishikawa	81235 7114	2440
37123 7590 12/13/2007 FITCH EVEN TABIN & FLANNERY 120 SOUTH LASALLE SUITE 1600 CHICAGO, IL 60603				
EXAMINER				
TAYLOR, JOSHUA D				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/806,767

**Applicant(s)**

NISHIKAWA ET AL.

**Examiner**

Josh Taylor

**Art Unit**

4157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/55/08)  
Paper No(s)/Mail Date 8/12/2004
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claim 1 objected to because of the following informalities: The first two lines of the claim should be amended to read:

"A method in an audio/video programming guide apparatus comprising:" .

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 8-12 pertain to characteristics of an electronic program guide (EPG). An EPG is a data file, by definition, is non-functional descriptive material, and thus, is not patent eligible. See MPEP 2106.01 (II). Conversely, functional descriptive material qualifies as "data structure" per se, and can impart functionality when embedded in a computer readable medium and executed by a computer. See MPEP 2106.01. Assuming, for the sake of argument, that EPG is indeed "data structure", by itself as claimed, is not realizable because it does not fall under one of the four statutory categories of a process, machine, article of manufacture, or composition of matter.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in **Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)**, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: (*See MPEP Ch. 2141*)

- a. Determining the scope and contents of the prior art;
  - b. Ascertaining the differences between the prior art and the claims in issue;
  - c. Resolving the level of ordinary skill in the pertinent art; and
  - d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.
2. Claim (1-15) rejected under 35 U.S.C. 103(a) as being unpatentable over Fries et al., US 2004/0078807 in view of Sie et al., US 2003/0233656.

Regarding claims 1, 8, and 13, Fries et al. discloses as claimed a method in an audio/video programming guide apparatus, an interactive programming guide, and a method of providing a programming guide (figs. 1, 5, Abstract, para 0012-0014) comprising:

providing access to characterizing descriptors as individually correspond to a plurality of discrete selectable items of audio/video content, wherein at least some of the discrete selectable items of audio/video content differ from one

another with respect to at least one of: bearer media; primary transmission service provider; data format (see fig. 4, [0043]).

Fries et al. does not explicitly disclose providing at least one selection criterion; applying the at least one selection criterion with respect to the characterizing descriptors to provide a resultant selection of the plurality of discrete selectable items of audio/video content; displaying programming guide information comprising information regarding at least a portion of the resultant selection as claimed. However, Sie et al. does as a way to include programs that meet the user's classification and/or category preferences (paragraph [0087]).

Therefore, one skilled in the art would have found it obvious to use what is taught by Sie for a audio/video programming guide apparatus wherein at least some of the discrete selectable items of audio/video content differ from one another with respect to at least one of: bearer media, primary transmission service provider, or data format.

Claim 2 is the method of claim 1, the combination of Fries and Sie teaches comprising: responding to a remote control by scrolling through the programming guide information comprising information regarding at least a portion of the resultant selection (Fries, [0070], lines 1-5).

Claim 3 is the method of claim 1, the combination of Fries and Sie teaches comprising the following feature: detecting user selection of a particular one of

the plurality of discrete selectable items of audio/visual content (Fries, [0083], lines 3-5).

Claim 4 is the method of claim 1 and is rejected as applied to claim 1. Furthermore, Fries et al. does not disclose further comprising: a user database and wherein providing at least one selection criterion further comprises using information from the user database to characterize the at least one selection criterion to be provided. Conversely, Sie et al. does (paragraph [0087]). Sie et al. teaches that user information can be used to characterize selection criterion.

Claim 5 is the method of claim 4, the combination of Fries and Sie teaches comprising the following feature: wherein using information from the user database to identify the at least one selection criterion to be provided comprises: accessing information from the user database to discern preferences of a particular user; accessing the characterizing descriptors as individually correspond to a plurality of discrete selectable items of audio/video content; comparing the preferences of a particular user to the characterizing descriptors as individually correspond to a plurality of discrete selectable items of audio/video content (Sie, paragraph [0088]-[0090]).

Claim 6 is the method of claim 4, the combination of Fries and Sie teaches further comprising the following feature: responding to a remote control by

selecting a particular one of the plurality of discrete selectable items of audio/visual content (Fries, [0070], lines 1-5).

Regarding claim 7, it is rejected as applied to claim 1 above. Furthermore, Fries et al. does not disclose further comprising: wherein providing at least one selection criterion comprises: supplying at least one user-defined keyword; and matching the at least one user-defined keyword with at least one of the characterizing descriptors as individually correspond to a plurality of discrete selectable items of audio/video content. However, Sie et al. teaches this in paragraph [0082].

Claim 9 is the interactive programming guide of claim 8, the combination of Fries and Sie teaches further comprising: wherein the control circuitry comprises filter means for comparing the at least one selection criterion with at least some of the characterizing descriptors to provide the resultant selection (Sie, see paragraph [0088]).

Claim 10 is the interactive programming guide of claim 8, the combination of Fries and Sie teaches further comprising the following feature: wherein the at least one selection criterion is based, at least in part, upon a preference of a present viewer of the interactive programming guide (Sie, see paragraph [0090]).

Claim 11 is the interactive programming guide of claim 8, the combination of Fries and Sie teaches further comprising the following feature: wherein the at least one selection criterion comprises a user-defined keyword (Sie, see paragraph [0088]).

Claim 12 is the interactive programming guide of claim 8, the combination of Fries and Sie teaches further comprising the following feature: wherein the at least one selection criterion is retained in a database (Sie, see paragraph [0085]).

Claim 14 is the method of claim 13, the combination of Fries and Sie teaches further comprising the following feature, which Sie et al. teaches: wherein providing at least one selection criterion that corresponds to a given individual further comprises ascertaining an identity of a present viewer (Sie, see paragraph [0090]).

Claim 15 is the method of claim 14, the combination of Fries and Sie teaches further comprising the following feature: wherein providing at least one selection criterion that corresponds to a given individual further comprises further comprises using the identity to recall at least one previously stored selection criterion (Sie, see paragraph [0090]).



### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Josh Taylor whose telephone number is (571) 270-3755. The examiner can normally be reached on 8am-5pm, M-F, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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